

REMARKS

These remarks are being submitted in response to the Office action dated October 19, 2006 that was issued in connection with the above-identified patent application. Claims 1-14, 17, and 18 are pending in the application.

In the Office action, the Examiner rejected claims 1, 17, and 18 on the grounds of obviousness-type double patenting over claims 1-3, 6, and 23 of U.S. Patent No. 6,918,521 to Settelmayer, et al. ("Settelmayer"). Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,582,313 to Envall ("Envall") in view of U.S. Patent No. 3,008,177 to Wooten, Jr. ("Wooten"). Claims 3-14, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Envall in view of Wooten and further in view of U.S. Patent No. 6,296,278 to Zupancic, et al. ("Zupancic"). Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Envall in view of Wooten and Zupancic and further in view of U.S. Patent No. 6,296,161 to Van der Feen, et al. ("Van der Feen").

Applicants traverse these rejections. In view of the remarks below, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Rejection based on obviousness-type double patenting

Claims 1, 17, and 18 were rejected on the basis of obviousness-type double patenting as being unpatentable over claims 1-3, 6 and 23 of Settelmayer. The Examiner asserts that the pending claims are not patentably distinct from the claims of Settelmayer because Settelmayer recites a car top carrier with the "same structure such as the box, having at least one clamp device comprising of the jaw device and the cam lever." Office action, pg. 2. For the double-patenting rejection to be appropriate, two things must be present: 1) the rejection must make clear both i) the differences between the inventions defined by the conflicting claims, and ii) the reasons why a person of skill in the art would conclude that the invention defined in the claims at issue would have been an obvious variation of the invention defined in the claims of the earlier patent, and 2) the claims in the application must define an invention that is not patentably distinct from the claimed invention in Settelmayer. MPEP 804(II)(B)(1). Neither of those situations applies here.

First, though the Examiner has noted the content of the conflicting claims at issue, and (therefore, implicitly) the differences between the claims, there is no clear statement of the differences between the conflicting claims. As well, the Examiner has not provided any explanation for the reasons why a person of skill in the art would see the presently-claimed invention as an obvious variation of the claimed invention in *Settelmayer*. In the absence of these factors, the rejection must fail.

Second, even if the first requirements were met, the claims in the present application define an invention that is patentably distinct from the invention claimed in *Settelmayer*. The claims in *Settelmayer* are directed to clamp devices for securing a box to a crossbar. In contrast, the claims in this application are directed to hinge devices for connecting a lid to the bottom of a box. Therefore, the claims in the application and patent are directed to very different subject matter. Moreover, *Settelmayer* does not even disclose the hinge devices shown in Figures 12-18 of the current application. Therefore, the double patenting rejection should be withdrawn.

Rejections under 35 USC § 103(a)

The Examiner rejected all pending claims under 35 U.S.C. 103(a) as being obvious to one of ordinary skill in the art. Various combinations of several references were used in rejecting the claims.

In applying 35 U.S.C. § 103, the references must suggest the desirability, and thus, the obviousness of making the combination. As stated by the Federal Circuit in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992):

[T]he Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. 'The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' ... Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the invention.'

Id. at 1265-1266 (citations omitted). The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136 (Fed. Cir. 1986).

Hindsight reconstruction is evidenced by defining the problem in terms of its solution. Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 882 (Fed. Cir. 1998). Each of the obviousness rejections set forth in the Office action is defined in terms of a basic car top carrier from one reference, with elements from other references added as they are recited in each claim. Since each of the rejections have been grounded in the solution recited in each claim and since elements of the prior art were picked and chosen without any teaching or suggestion to do so, Applicants respectfully submit that the rejections are not properly supported and should therefore be withdrawn.

Claim 1

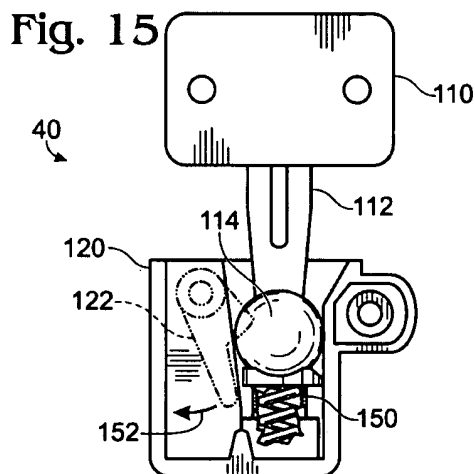
Claim 1 is presented below and is directed to a car top carrier that includes a box, a clamp device that attaches the box to a pair of crossbars, and one or more hinge devices connecting portions of the box to each other.

1. (Original) A car top carrier comprising:
a box having a lid and a bottom,
a clamp device configured to attach the bottom of the box to a pair of crossbars on top of a car,
one or more hinge devices releasably connecting the lid to the bottom, each hinge having a first portion secured to the lid, and a second portion secured to the bottom, the hinge being configured to permit pivotal rotation of the lid along an edge portion of the bottom, and being provided with a release mechanism so that the hinge device can also function as a latch allowing separation of the first and second portions of the hinge device, wherein the hinge device automatically snaps into engagement when the first portion is urged toward the second portion.

As noted above, claim 1 was rejected as being unpatentable over Envall in view of Wooten. The Examiner cited Envall for its teaching of a box having a lid and a bottom, a clamp device configured to attach the bottom of the box to a pair of crossbars on top of a car, and one or more hinges releasably connecting the lid to the bottom. Wooten was cited as disclosing "a release mechanism so that the hinge device can function as the latch...wherein the hinge device automatically snaps into engagement" when portions of the hinge are urged toward one another. Office action, pg. 4. However, Applicants note that Wooten does not teach a hinge device that can also function as a latch that

automatically snaps into engagement when portions of the hinge are urged toward one another, as required by claim 1. Therefore, the Examiner's proposed combination cannot result in the claimed subject matter.

One view of an embodiment of Applicants' recited hinge devices is shown in Applicants' Figure 15, below. As depicted in the Figure, a user may urge a first portion 114 of a hinge device toward a second portion 120 of the hinge device. Downward motion of first portion 114 pushes a spring-biased pawl 122 of the second portion 120 out of the way of the first portion until, when the first portion reaches the appropriate position, the pawl snaps over the top of the first portion and engages it. In this manner, Applicants' hinge device automatically snaps into releasable engagement when the first portion 114 is urged toward the second portion 120. As required by the word "automatically" in Applicants' claim 1, user manipulation of the claimed hinge device is limited to urging the first portion of the hinge device toward the second portion, with locking engagement occurring via an "automatic" mechanism that requires no further intervention by the user.



In contrast to Applicants' claimed hinge mechanism, the device of Wooten requires user manipulation at all steps of operation of the disclosed hinge and thus does not disclose, teach or suggest an automatic snapping engagement mechanism between two hinge portions. The hinge disclosed in Wooten, shown in Wooten Figure 1 below, requires that a user urge two portions of a hinge into close relation and then manually engage a third portion as a locking mechanism. The Wooten hinge has a first, upper portion 7 that may be urged closer to a second, lower portion 8. When the first and second portions of the Wooten hinge are in an appropriate position, a user may engage a third, locking, portion 16 that maintains a fixed relation between the first and second portions. Manipulation by the user is required to fully engage the hinge lock of Wooten, even after the user urges first and second portions of the hinge together.

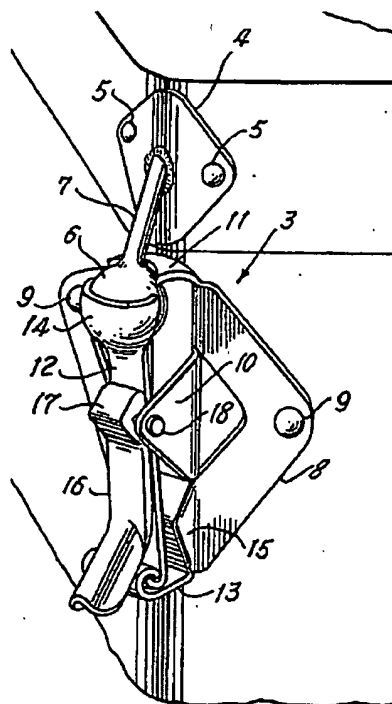


Fig. 1

Though Wooten discloses a hinge having at least first and second portions that may be urged closer together, it is clear that the hinge of Wooten does not "automatically snap[] into engagement when the first portion is urged toward the second portion," as required in Applicants' claim 1. As well, Wooten does not teach or suggest that the disclosed hinge mechanism can operate in anything other than a manual-engagement mode.

Claims 2-5, 17, and 18 depend from and further limit independent claim 1. Therefore, the rejections of claims 2-5, 17, and 18 should be withdrawn and those claims should be allowed when claim 1 is allowed.

Claim 6

Claim 6 is presented below and is directed to a car top carrier that includes a box, a clamp device that attaches the box to a pair of crossbars, and one or more hinge devices connecting portions of the box to each other.

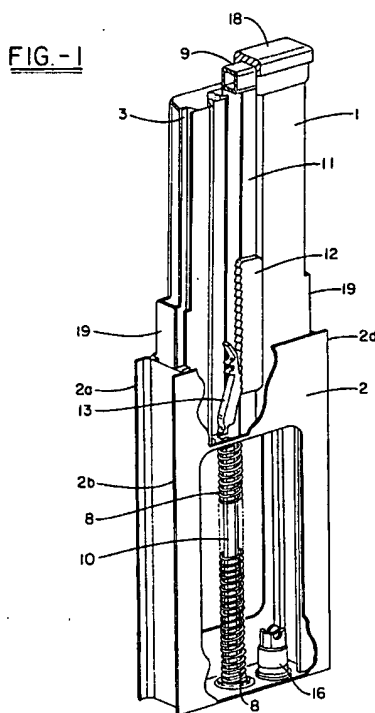
6. (Previously Amended) A car top carrier comprising:

- a box having a lid and a bottom,
- a clamp device configured to attach the bottom of the box to a pair of crossbars on top of a car,
- one or more hinge devices releasably connecting the lid to the bottom, each hinge having a first portion secured to the lid, and a second portion secured to the bottom, the hinge being configured to permit pivotal rotation of the lid along an edge portion of the bottom, and being provided with a release mechanism so that the hinge device can also function as a latch allowing separation of the first and second portions of the hinge device, wherein one of the first and second portions has a catch including a pawl that is spring biased toward a constricted-passage position, and the other portion has an enlarged structure configured for receipt by the catch, and further wherein the pawl can be pushed aside by the enlarged structure upon entry but not upon exit of the catch.

As noted above, claim 6 was rejected as being unpatentable over Envall in view of Wooten and Zupancic. The Examiner cited Envall for its teaching of a box having a lid and a bottom, a clamp device configured to attach the bottom of the box to a pair of crossbars on top of a car, and one or more hinges releasably connecting the lid to the bottom. Wooten was cited as disclosing a release mechanism with a hinge mechanism that can function as a latch, wherein the hinge device automatically snaps into engagement when portions of the hinge are urged toward one another. Zupancic was cited for its disclosure of a spring-biased pawl that is biased toward a constricted-passage position in a catch. Applicants appreciate the Examiner's thoroughness in

making the proposed combination, but feel that the proposed combination of references does not make obvious Applicants' claimed subject matter.

The structure disclosed in Zupancic is shown below in Zupancic Figure 1. The Zupancic structure is a rapidly-deploying protective bar for use in a situation where an automobile is in a rollover accident. The device of Zupancic consists of an elongated bar 1 including a toothed rack 12. The toothed rack is positioned to rest against a spring-loaded locking pawl 13 which holds the bar in an extended position when the bar has been deployed in the direction of its long axis.



There is no teaching, suggestion or motivation in any of the references to make the proposed combination. As well, Applicants note that implementing the structure of Zupancic into the hinge of Wooten would make the resulting hinge inoperable and would not fulfill one of the requirements of Applicants' claimed invention.

First, Applicants note that there is no teaching or suggestion to make the combination proposed by the Examiner. The disclosure of Wooten is restricted to a discussion of the physical features of the claimed hinge structure; no attempt is made to discuss favorable modifications to the disclosed device or to discuss in detail its place in relation to the art. Zupancic discloses a rapidly extendable bar useful in a rollover

protection apparatus in a car; again the discussion is to the structural advantages of the disclosed bar and extension mechanism and there is no hint of modifications to the structure that might reach Applicants' claimed invention. Because neither reference discusses the types of modifications or improvements that might result in the subject matter recited in Applicants' claim 6, there can be no teaching or suggestion from those references to make the proposed combination. Accordingly, on this ground alone the references cannot make obvious Applicants' claim 6.

Even assuming a teaching or motivation can be found in the references, Applicants note that implementation in Wooten of the structure disclosed in Zupancic would make the resulting hinge nonfunctional for its intended purpose. Also, attempting to combine the structures of Zupancic and Wooten would prevent the combined device from fulfilling the requirement of the hinge recited in Applicants' claim 6: that it "permit pivotal rotation of the lid...."

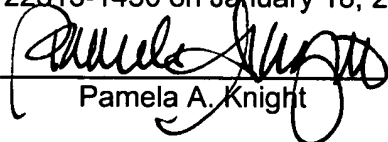
Wooten states that an object of its disclosed hinge is to "pivotally connect the lid to the trunk" and to provide "universal pivotal movement relative thereto." Wooten col. 1, lines 13-14. For this purpose, Wooten provides structures that, together, form "a ball and socket joint whereby the lid is connected to the trunk for universal pivotal movement relative thereto." Wooten col. 2, lines 20-22. Because the structure of Zupancic was designed and optimized for uniaxial operation it is not capable either of forming a ball-and-socket structure or of allowing "universal pivotal movement"; both favorable aspects of the Wooten invention. Also, because the pawl structure of Zupancic is built along a single axis, and is designed to facilitate movement only along that axis, it would destroy the ability of any resulting hinge to "permit pivotal rotation" of a lid of a car top carrier. The absence of these essential features from Zupancic, and the destruction of the operation of the Wooten device if they were incorporated into it, counsels against the proposed combination of Envall, Wooten, and Zupancic. Accordingly, the combination of Envall, Wooten, and Zupancic would not have rendered obvious the invention recited in Applicants' claim 6. Therefore, that claim should be allowed.

Claims 7-14 depend from and further limit independent claim 6. Therefore, the rejections of claims 7-14 should be withdrawn and those claims should be allowed when claim 6 is allowed.

Applicants believe the application is in condition for allowance, in view of the above remarks. Applicants thank the Examiner for the thorough examination of this application. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on January 18, 2007.


Pamela A. Knight

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Pierre C. Van Rysselberghe

Registration No. 33,557

Customer No. 23581

Of Attorneys for Applicants

200 Pacific Building

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679